Remarks

Claims 19-24 and 29-35 remain in the application. Claims 19 and 24 are amended. Claims 25-28 are cancelled. Claim 35 has been added to the application.

Applicant has cancelled claims 25-28 as requested by the Examiner.

Claim Rejections Under 35 USC § 103(a)

Claims 19-24 and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creswell et al., U.S. Patent No. 6,564,263.

Applicant traverses the present objection to claims 19 and 29 as follows:

Creswell teaches a server for redirecting electronic messages of intended recipients in response to incorrect recipient destination information. For example, when an address of an incoming message is unknown, user search rules are activated on a server to determine a correct destination address of an intended recipient to allow the message to be directed toward its intended destination. The system of Creswell relies on a server for intercepting messages before they are directed to a recipient.

Also, at column 4, Creswell discloses a system for resolving incorrect addresses in outgoing messages that have been returned due to incorrect destination addresses. Here, a first contact system acts to correct contact data of a destination other than the first contact system. This is analogous to fixing an address on a letter that is returned due to incorrect address information.

The system of Creswell operates on and to correct messages that are misdirected. Thus, it is always address information of another party that is sought since the address information of the sender is known.

In contrast, Claim 19 reads as follows (highlighting my own):

7

Appln No. 10/773,958
Response to Office Action mailed June 23, 2005

Claim 19 (original) A method for updating an electronic contact information database comprising the steps of:

receiving an electronic message at a system of a contact by an electronic message application;

intercepting the electronic message by an automated reply filter cooperatively in execution with the electronic message application prior to storage thereof within an inbox of the electronic message application;

parsing information fields within the intercepted electronic message to determine that the electronic message is one of an update request message and another message;

providing all other messages for storage within the inbox;

generating a new electronic message including data indicative of current contact information **for the contact** in reply to a determined update request message; and

transmitting the generated new electronic message via a communication network.

In its incoming message embodiments, Creswell does not receive a message at a system of a contact. Creswell is applied at a server disposed between a transmitting system and a receiving system. Messages that are OK are passed onto the system of the contact. Those that are determined to need processing are held for processing before being redirected. Clearly, claim 19 refers to the electronic message which is the electronic message received in the previously recited limitation. As such, claim 19 is distinct from this embodiment of Creswell.

The recited portion of Creswell, column 4, refers to receiving what is commonly referred to as "bounced" messages. The purpose of the disclosure of Creswell is to retransmit the "bounced" message to its intended recipient. This does not relate to replying to an update request with data indicative of current contact information **for the contact**. Creswell updates the contact information of a party to whom the message is being sent not of the contact – the party receiving the update request. Data for the contact is not provided "in reply" and Creswell does not teach this.

8

Appln No. 10/773,958
Response to Office Action mailed June 23, 2005

It is respectfully submitted that the examiner is taking portions of the processing of outgoing messages and of the processing of incoming messages and is combining these in a fashion inconsistent with the teachings of Creswell and using hindsight as a guide. This is inappropriate under U.S. Patent law as any combination or modification of teachings cited MUST be motivated without hindsight.

There is no indication in Creswell of all the steps recited within claims 19 and/or 29. At column 4 there is recited, "receiving an electronic message at a system of a contact." The next limitation is not disclosed as there is no disclosure of "prior to storage thereof within an inbox of the electronic message application." Though parsing of the message is disclosed, it is not disclosed to "determine that the electronic message is one of an update request message and another message." The examiner has admitted that there is no disclosure of "providing all other messages for storage within the inbox." Of course, why would there be when, in accordance with Creswell, the message destination is not the system of the contact. Finally, Creswell does not teach "generating a new electronic message including data indicative of current contact information for the contact in reply to a determined update request message."

Applicant asserts that a message as received in Creswell is not an update request message. There is no request portion of the message and though it may necessitate a correction of a destination address, the message is not parsed to determine that it is an update request message, it is parsed to determined that it is a failed message or an erroneous message. It is asserted that there is a significant difference between an update request message and a problem message.

It would not be obvious from the disclosure of Creswell to add the limitation "providing all other messages for storage within the inbox", as recited in independent claim 19. Creswell does not address this step and, absent hindsight, it is not obvious to add same to Creswell.

9

Appln No. 10/773,958
Response to Office Action mailed June 23, 2005

Further, the limitation of "generating" is not performed in Creswell. A careful review of that reference establishes the following: When a message is incoming, the system detects a lack of suitable addresses and redirects the message. There is no "update request message." To the best of the applicant's understanding, the "update request message" proposed to have been disclosed by Creswell is a return message. In this case, the "new message does not include "data indicative of current contact information for the contact in reply to a determined update request message."

In order to support an objection under 35 U.S.C. there must be a disclosure of all elements of a claimed invention and a motivation to combine those elements. Here there is clearly no such disclosure and further there is no motivation to combine.

Creswell addresses a different problem, is operable for a different purpose, and does not disclose each and every one of the recited limitations set out.

The arguments above relating to claim 19 apply to claim 29 mutatis mutandis. Further, there is no motivation to provide for "deleting" within the Creswell reference. It is unclear where in that disclosure it is suggested that deleting of inbound messages was to be performed. Since the disclosure of Creswell is silent as to what is done with the messages, it cannot render claims to specific courses of action. Of course, in the disclosure of Creswell, because for a contact only a small number of "bounced" messages is typical, there is no motivation to delete the "bounced" messages. In the present application, a number of update requests may be substantial and an operation of the method in a transparent fashion as defined in claims 19 and 29 is highly advantageous.

Further, there is an unforeseen advantage in the application as described in contrast to the teachings of Creswell. With the teachings of Creswell, it is a straightforward process to use a contact system to spam recipients within their address book. A spoof is applied to a message such that it appears to originate from the address of the contact. When the message "bounces" the contact system automatically redirects it appropriately. As such, it

10

Appln No. 10/773,958
Response to Office Action mailed June 23, 2005

is difficult to trace the origination of the spam. Thus, the addition of deleting messages or of not storing them in the inbox of the "contact" of Creswell is unadvisable.

It is respectfully submitted that due to the broad interpretation of Creswell, the examiner has interpreted that reference in manners that render the resulting system absurd or completely unworkable. It is a well-defined principle of U.S. patent law that a reference must be one such that one of skill in the art with a mind willing to understand will interpret it as such. Here, a person of skill in the art would not see the "obviousness" of adding either of the non-disclosed limitations to the teachings of Creswell.

Referring to claims 21 and 33, there is no teachings within Creswell of treating any of the received messages differently other than to resolve incorrect destination addresses. As such, claim 21 cannot properly be considered obvious. Clearly there are always options such as doing something or not doing it. This does not render each of the options obvious. The examiner has asserted that several different options, providing the messages to the inbox, not providing them, and deleting them are all obvious. Applicant traverses these assertions. Therefore, Claim 21 is allowable.

Referring to claim 22 and 31, clearly nothing in Creswell teaches "providing updated contact information to a first system, the updated contact information relating to a user of the first system." As such, claim 22 is not obvious in view of Creswell. Creswell addresses providing updated contact information of a destination to a first system and not of a user of the first system to the first system. Therefore, Claim 22 is allowable.

Referring to Claim 23 and 34, it makes no sense to cite Creswell against said claim. There is no application in Creswell wherein the system comprises two separate ends. In particular, the updating within the system taught by Creswell occurs at a same system as the system that resolves the address data (see Column 4), which does not fall within the wording of claim 23. As such, claim 23 is allowable.

11

Appln No. 10/773,958
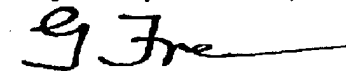Response to Office Action mailed June 23, 2005

Referring to claim 24 as amended, the teachings of Creswell do not teach providing the updated contact information from the first system. In fact, since the system of Creswell is trying to solve for misdirected communication, it is unsure where the first system is. It therefore looks to other systems – for example, an address book of the contact – for address information of the intended recipient of the message (not the contact). For example, when a message is received at the contact system (see column 4) and is a "return message" or a "bounced" message, the intended address must be corrected. This is the intended address of a party other than the contact. Thus, such an embodiment as disclosed does not fall within the scope of claim 24 and cannot render that claim obvious. In contrast, for a received message, the disclosure is also not applicable to claim 24. Here, the intended destination is unknown and an intermediate server transmits requests to databases to determine a correct destination address. When the disclosure is interpreted such that the intermediary server is the contact system (which the applicant asserts is an inappropriate interpretation), it is not the address of the server that is determined. Clearly, the address of the destination is determined from other than the destination system.

As such, there is nothing in the teachings of Creswell that reads on claim 24 as amended and no modification thereto that is motivated provides for determining from a system of a contact contact-information for that contact. As such, claim 24 as amended is allowable.

The dependent claims depend from independent claims that are allowable and as such are allowable.

Please charge any additional fees required or credit any overpayment to Deposit Account No. 50-1142.

Respectfully submitted,

Gordon Freedman, Reg. No. 41,553

Freedman and Associates	Tel: (613) 274-7272
117 Centrepointe Drive, Suite 350	Fax: (613) 274-7414
Nepean, Ontario K2G 5X3 Canada	Email: gordon@freedmanandassociates.ca

12